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Remarks

Claims 24-68 are pending in this application.

Rejections under 35 USC 103(a)

Claims 24-63 and 66-68 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the User's Guide Data Digger Version 6 publication, in view of Slotznick (US 5,983,200), and further in view of Official Notice. Claims 64 and 65 have been rejected as being unpatentable over the User's Guide Data Digger Version 6 publication in view of Slotznick as applied to claim 24, and further in view of Tavor et al (US 6,070,149), and Official Notice. These rejections are respectfully traversed.

In the previous amendment, independent claims 24, 48, 66, and 67 were amended to recite features that are neither disclosed nor suggested by the cited art. In particular, claims 24, 48, and 67 recite, *inter alia*, the limitation of "displaying a selection guide on the computer, said selection guide providing choices; customizing sequence of information and further choices presented by said processes adapted to guide the user in electronically planning the funeral ceremony based on selection of said choices on said selection guide." Claim 66 recites, *inter alia*, the limitation of "said funeral planning routine instructing said computer to display a selection guide, said selection guide providing choices comprising type of disposition, and to customize sequence of information and further choices presented by said processes adapted to guide the user in electronically planning the funeral ceremony based on selection of said choices on said selection guide."

The Applicants note that the Data Digger publication explicitly states that Data Digger uses five funeral record pages or screens to enter information stored in their operational files, and that each screen contains fields where particular pieces of information are requested. See pages 28-29. The Data Digger publication also states that a user is automatically taken to the next screen by pressing the enter key on a keyboard after filing in the last entry field on any page, or either the page up/down keys or F5 and the page number corresponding to the desired screen. See page 11. The Data Digger publication further states that unwanted fields may be removed from the screen by creating an "except" file.

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See page 29. This "except" file is read during the boot-up of the Data Digger software, and therefore the screens are not customizable while the application is running and being used by the user. See A.18.

Accordingly, the Applicants note that the "guiding" provided by the Data Digger software is typically a sequential data entry method, which provides no guiding feature to the funeral planning that customizes the sequence of information and further choices presented by the processes adapted to guide the user in electronically planning the funeral ceremony based on selection of choices on a selection guide as recited by the amended independent claims.

Slotznick is cited for disclosing a computer for making plans that display images for selection and for allowing the user to modify or accept the plan. Accordingly, the combined teachings of the User's Guide Data Digger Version 6 publication and Slotznick fails to disclose or suggest the above noted limitations of amended independent claims 24, 48, 66, and 67.

Tavor et al is cited for shopping over the internet that uses multimedia presentations to make the session more enjoyable for the customer. Accordingly, the combined teachings of the User's Guide Data Digger Version 6 publication, Slotznick, and Tavor et al. fails to disclose or suggest the above noted limitations of amended independent claim 48, from which claims 64 and 65 depend.

However, in order to correct the above noted deficiencies in the cited art, the Examiner in the current Office Action now has taken official notice "that it has been common knowledge within the funeral industry to present to the consumer a plurality of choices and customize information of further choices in planning a funeral ceremony." Such official notice is improper.

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Lee*, 277 F. 3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002)(The court reversed the Board's decision in sustaining a rejection under 35 U.S.C. 103 and stated that "common knowledge and common sense" on which the

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Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation....The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies").

The Federal Circuit in *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001), reversed the Board's decision upholding a rejection under 35 U.S.C. 103 for lack of substantial evidence. Specifically, in *Zurko*, the court criticized the USPTO's reliance on "basic knowledge" or "common sense" to support an obviousness rejection, where there was no evidentiary support in the record for such a finding. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("the Board cannot simply reach conclusion based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). Therefore, holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection.

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement" See also *In re Fox*, 471, F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). Unlike in *Ahlert* or *Fox*, the Office Notice used by the Examiner in the present matter to "fill in the gaps" that exist in the evidentiary showing in order to support a particular ground for rejection is not capable of such instant and unquestionable demonstration as to defy dispute.

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The USPTO provides the following example of facts beyond the record which may be taken by the examiner as being capable of such instant and unquestionable demonstration as to defy dispute.

An example of a technical line of reasoning is a hypothetical application in which a claim to an apparatus contained elements of a computer and pointing device. An examiner found art showing a computer and a mouse. The examiner could take notice that the mouse is a device used by the computer operator to indicate where on the screen the cursor was to be positioned, which is a form of pointing on the screen, and therefore the mouse is a pointing device. Other examples in other arts include taking official notice of molecular weights of elements in the Periodic Table, or the ph level of certain acids or bases. See Question 9 at <http://www.uspto.gov/web/menu/pbmethod/summer2002qanda.html>

In the present matter, the Examiner found art showing a funeral planning method employing a computer (Data Digger), a computer for making plans that displays images for selection (Slotznick), and a computer for shopping over the Internet that includes multimedia presentations to make the session enjoyable for the customer (Tavor). However, as pointed out above, neither Data Digger, Slotznick, nor Tavor, provides the teaching, suggestion or inspiration of providing a guiding feature to computerized funeral planning method that customizes the sequence of information and further choices presented by the processes adapted to guide the user in electronically planning the funeral ceremony based on selection of choices on a selection guide as recited by the independent claims. As there is no motivation, it cannot be assumed that one skilled in the art would know to modify the cited combination of the prior art in order to produce the claimed invention based solely on a general statement. Accordingly, no *prima facie* obviousness has been established as the record fails to indicate the facts upon which the conclusion was based and how the conclusion is properly reached from those facts.

The Applicants are unaware of any reference that provides the motivation, suggestion or incentive supporting the combination and modification of the teachings of the cited prior art in order to produce the claimed invention. As such, the Applicants


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request that the Examiner produce evidence to support his Official Notice statement, which in order to provide sufficient basis for establishing *prima facie* obviousness, would have to show that it is common knowledge within the funeral industry to modify a funeral planning method employing a computer such that a customer is presented on the computer a plurality of choices and for the computer to customize the sequence of information and further choices presented by the computer based on selection of previous choices when electronically planning the funeral ceremony. If such evidence is not provided in the next office action, withdrawal of these rejections and allowance of the claims is respectfully requested.

Conclusion

Applicants respectfully submit that in view of the above remarks the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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